

26                    11. (New) The support and insulating system of claim 10 wherein  
27                    said material is selected from the group consisting of expanded, extruded or  
28                    molded polystyrene foam plastic.

1                    12. (New) The support and insulating system of claim 9 wherein  
2                    the support and insulating system has a length and thickness adapted for  
3                    corresponding to and for filling the hollow space between the corner post and  
4                    the external wall of the building along the entire length of the corner of the  
5                    building.

#### **REMARKS**

Upon entry of this Amendment Claims 1-12 are amended and Claims 13-23 are cancelled. Claims 1-12 are pending.

The Reissue Oath/Declaration originally filed with this Application was considered defective. The examiner enumerated the deficiencies in the Reissue Oath/Declaration, as required by 37 C.F.R. 1.63. A new and supplemental Reissue Declaration will be submitted at a later date as permitted by the Examiner in a telephone interview.

Claims 1-23 were rejected as originally filed under 35 U.S.C. 251 as lacking basis for reissue because by statute, a reissue application can only be granted for the unexpired portion of the term of the original patent. The examiner indicates that there is no record of a 3.5 year maintenance fee being paid for U.S. Patent No. 5,542,222 of which the term of U.S. Patent 5,664,376 shall not extend beyond. Enclosed is the maintenance fee statement indicating that the 3.5 year maintenance fee for U.S. Patent No. 5,542,222 was paid and received by the U.S. Patent Office. The supplemental/substitute reissue declaration will declare that the subject application is a reissue of USPN 5664376.

Claims 5-23 were rejected under 35 U.S.C. 251 as being an improper recapture of broadening claimed subject matter surrendered in an application for the patent upon what the present reissue is based. The

recapture rule as pertained to the reissue will be discussed during discussion of the new claims.

Claims 1-8, 12, and 16-20 were rejected under 35 U.S.C. 112 in the second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the examiner stated that the scope of the claims is rendered indefinite by the language "have lengths corresponding to the length of the corner of the building" and "has a length and thickness corresponding to and for filling the hollow space between the corner post and external wall of the building". The preamble further indicates that any relationships to the intended use environment must be made functionally. The inconsistency between the preamble and the body of the claims renders the entire scope of the claims indefinite. In addition, in claim 5 and in claim 17 the phrases "the first plane" and "said single member" respectively lack proper antecedent basis.

Claims 1, 4, 5, 8, 9, and 12 have been amended such that any relationship to the intended use environment of the member is made functionally. Claims 1, 5, and 9 have been amended to require that the single "member has first and second longitudinal extending portions... wherein the first and second longitudinal extending portions have lengths adapted for corresponding to the length of the corner of the building". Claims 4, 8, and 12 have been amended to require that the support and insulating member or the supported and insulating system has a length and thickness adapted for corresponding to and for filling the hollow space between the corner post..."

Claim 5 has been amended to require "the first portion lying in a first plane" at lines 8-9.

Claims 1, 2, 5, 6, 9, 10, 13, 14, 17, 18 and 21-23 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,455,797 to Naka. Claims 1-12 have been amended to overcome this rejection and now require a first support member flange lying in the first plane and extending outwardly from said first portion at a predetermined distance and a second support member flange lying in the second plane and extending outwardly from

said second portion a predetermined distance. The amendment to the claims are supported in Figs. 1-3 in U.S. Patent No. 5,664,376 ('376). Patent '797 to Naka shows a single member having first and second longitudinally extending portions at 51 and 18 (Fig. 4). The first portion lies in the first plane and the second portion lies in the second plane and angularly disposed with respect to each other. However, Naka does not show a first support member flange and a second support member flange lying in the first and second planes respectively. The support member flange at 13 does not lie in the plane of portion 18. Therefore, claims 1-12 are distinguished from Naka.

Claims 1, 5, 9, 13, and 17 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 2,091,316 to Hauck. Claims 1-12 have been amended to overcome the rejection under 35 U.S.C. 102(b) by patent '316 to Hauck. In particular, Claims 1-12 are amended to claim a support and insulating member (Claims 1-4) or a supported and insulating system (Claims 5-12) for a corner post as supported in column 2, lines 7-10 in patent '376. Hauck's member is not an insulating member. Further, Claims 1, 5 and 9 require that the first support member flange lies in the same plane as the first longitudinally extending portion (the same argument refers to the second plane of the second flange and second portion). In Hauck, the difference in the planes that the flanges lie relative to the planes that the portions lie is the thickness of the wood pieces (as shown in Figures 2 and 3 of Hauck). In addition, Claim 5 has been amended to require a first support member flange integrally connected to the first portion and a second support member flange integrally connected to the second portions, as supported in the Figs. 1-3 in patent '376. Hauck shows two pieces of wood connected together to form its support member. Hauck does not show or disclose the flange portions integrally formed with the first and second extending portions. For the aforementioned reasons, claims 1-12 are believed to be distinguished from Hauck.

Claims 1, 5, 9, 13, and 17 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,430,833 to Balzer, et al. Claims 1,

5, and 9 now require that the member is a support and insulating member or a supported and insulating system. Patent '833 to Balzer does not show or disclose that its member is an insulating member. Further, Balzer is not a single member wherein the single member defines a cornered inner surface and a spaced apart cornered outer surface parallel to the cornered inner surface. As now required in Claims 12 and 5 and shown in Figures 1-3 in patent '376. The cornered outer surface is a second cushion pad in Balzer. Further, the cushion pad is not cornered, but arcuate. Claim 9 now requires that the first and second longitudinally extending portions intersecting for defining a cornered inner surface and a spaced apart cornered outer surface as disclosed in Figs. 1-3. This feature is not shown or disclosed in Balzer. Therefore, Claims 1-12 are believed to be distinguished from Balzer.

Claims 3, 4, 7, 8, 11, 12, 15, 16, 19, and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,455,579 to Naka. The prior aforementioned amendments to claims 1, 5, and 9 should place the claims in condition for passing to issue. Since claims 3, 4, 7, 8, 11, and 12 are ultimately dependent upon the aforementioned now allowable claims, they are believed to be allowable also.

Referring back to the rejection of an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based, the Examiner alleged that the limitations "single member" and/or "wherein said first and second longitudinally extending portions have lengths corresponding to the length of the corner of the building" have been omitted from the Claims. The Examiner stated that these limitations were present in amendments in Application Serial Number 08/639,698 filed on April 29, 1996 and December 6, 1996. The Examiner further states that the Applicant's Remarks in these amendments contain arguments that these limitations make the Claims allowable over the prior art of record. The omitted limitations relate to subject matter previously surrendered in Application Serial Number 08/639,698.

The term "single member" was added to parent case, Serial Number 08/355,471 (now USPN 5,542,222) to distinguish over U.S. Patent Number 4,827,683 issued to Poole. Poole discloses in Figures 1 and 2, two separate members, 16 and 18, which form the first and second longitudinally extending portions. The support member in Poole, made by the two members 16 and 18, form a longitudinal crack 20 between the side edge of member 16 and the rear face of member 18. As a result, Poole must cover the crack with an extending part 44 of the ridge 38 on member 16. The amendment to parent case Serial Number 08/355,471 stated that the applicant's invention includes a single member forming the support member which has no longitudinal crack and which must be covered. Therefore, the intent of the term "single member" was to mean: a whole member, an unbroken member, or an integral member, etc. having first and second longitudinally extending portions. In fact, the word "single" in Webster's Third New International Dictionary includes the definition as "consisting of a whole, unbroken, undivided". Therefore, it was the intent of the term "single member" to mean cross-sectionally a single member and not longitudinally a single member. The term "single member" was carried out through the continuation application Serial Number 08/639,698(now USPN 5,664,376). But, the intent of the term "single member" is not to mean a sole member or a single lone member corresponding to the length of the corner of the building. The support and insulating member or system may include one or more of these "single members". The Applicant did not surrender that more than one single member may be used along the length of the corner of the building.

The terminology "has a length corresponding to a length of the corner of the building" was added in a preliminary amendment when filing the continuation patent application, Serial Number 08/639,698, has filed on April 29, 1996. The phrase was put into a dependent claim referring to the support member. It is true that the support and insulating member has a length corresponding to a length of the corner of the building, but it is not true that one single (unbroken, whole, integral) member must have a length corresponding

to a length of the corner of the building. The patent '376 was amended in December of 1996 requiring that the first and second longitudinally extending portions have lengths corresponding to the length of a building. This phrase is remaining in the Claims. New Claims 5-12 are added to clarify the support and insulating member from the single member as required in Claim 1. Claims 5-12 now have replaced the term "member" in the preamble with the term "system". Claims 5-8 now claim a support and insulating system ... comprising at least two single members. Claims 9-12 now claim a support and insulating system ... comprising at least one single member. Changing the term "member" to --system-- should clarify and differentiate between a system which correspond to the length of a corner of a building and the single (or whole, or unbroken, or integral) members. Therefore, it is believed that the applicant is not attempting an improper recapture of broadened claimed subject matter previously surrendered; but that he is clarifying vague or misleading terminology by this reissue.

It appears that the Examiner prosecuting Patent No. 5,664,376 understood the Applicant's invention when he stated in his reasons for allowance that "no prior art of record, alone or in combination, teaches or fairly suggests a support member having first and second support member flanges extending outwardly from first and second portions of a single member, respectively, the first and second flanges extend continuously along the entire length of the first and second portions. The Examiner appears to have understood that it was not a requirement that one, sole member must extend the entire length of the building, but could comprise more than one of these single members to provide the system to have lengths adapted for corresponding to the length of the corner of the building.

Claims 1-23 were rejected under the judicially created doctrine of double patenting. Once the claims are deemed to be allowable a timely filed

terminal disclaimer may be submitted.

This amendment should place this case in condition for passing to issue. Such action is requested.

Respectfully submitted,

A handwritten signature in cursive script, reading "Darlene P. Condra". A long, thin, curved line extends from the end of the signature upwards and to the right.

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Attorney and Authorized Agent for Applicant

DPC/rnn

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